

REMARKS/ARGUMENTS

Reconsideration is hereby requested.

The Examiner has cited to *In re Venner*, 262 F.2d 91, 120 USPQ 193, 194 (CCPA 1958) for the proposition “that providing an automatic or mechanical means to replace a manual activity which accomplished the same result is not sufficient to distinguish over the prior art (the Examiner takes Official Notices here because these are old and well-known available computer programming applications).” In particular, the Examiner found that “storing a customer’s searches – e.g. in an IKEA store, a customer writes down which furniture items he selects and gives that list to a store’s cashier, that list would be entered with items’ descriptions, and items would be delivered to said customer after checking out (claim 12)” are fundamental in ecommerce and not inventive according to *In re Venner*.

However, as can be seen from more recent cases construing 35 U.S.C. §103, such as *In re Ochiai*, 71 F.3d 1565 (Fed. Cir. 1995), the test for obviousness requires “that one compare the claim’s ‘subject matter as a whole’ with the prior art ‘to which said subject matter pertains’ 35 U.S.C. § 103. The inquiry is thus highly fact-specific by design. This is so ‘whether the invention be a process for making or a process of using, or some other process. Kuel, 475 F.2d at 665, 177 USPQ at 225. when the references cited by the Examiner fail to establish a prima facie case of obviousness, the rejection is improper and will be overturned. *In re Fine*, 837 F.2d 1071, 1074 5 USPQ2d 1596, 1598 (Fed. Cir. 1988).”

The *Ochai* court went on to state that “[t]he use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention-- including all its limitations-- with the teachings of the prior art, flouts Section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for

fact-specific analysis of claims and prior art may be administratively convenient for PTO Examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with Section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention as *claimed* in the application is obvious over cited prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness, just as those precedents themselves expressly declined to create such rules. Any conflicts as may be perceived to exist derive from an impermissible effort to extract *per se* rules from decisions that disavow precisely such extraction.” *Ochai* at 1572

In addition, *Ex parte Brouillet*, 2001 WL 1339914 (BPAI 2001) (which is not binding precedent on the Board) states that Venner, “all limitations in the claims, including the automatic means, were disclosed in the applied references. See *Venner*, 262 F.2d at 96, 120 USPQ at 195” Therefore the Examiner must present a reference which discloses all of the limitations contained in Applicant’s application.

These and other cases caution against using hindsight to determine obviousness.

All claims have been rejected under 35 USC § 103(a) as obvious over Allard et al. over either Katz (with regard to Claims 1, 15-17, 19-20) or the Examiner’s Official Notice (with regard to claims 2-14, 16 and 18). Therefore, , the Examiner’s rejection of all claims depends upon the reference to Allard et al. (US Patent No. 6,249,773 B1, issued June 19, 2001). The Allard et al. application was not published under 35 USC § 122. In light thereof, it was not known, nor

could it be known through the exercise of due diligence to anyone, let alone one of ordinary skill in the art until the date of grant of the patent, June 19, 2001.

The instant application claims the benefit under 35 USC § 119(e) to an earliest non-provisional application Serial 60/183,186, filed February 17, 2000. Even assuming *arguendo* that this claim to priority is not controlling, the instant application has an actual filing date of February 16, 2001. This date is clearly four (4) months prior to the publication date of Allard et al. Clearly, as of February 16, 2001, one of ordinary skill in the art would not necessarily have been an employee of IBM. Neither would one of ordinary skill in the art necessarily have inside, trade secret, confidential or personal knowledge of Allard et al. activities or efforts to reduce said invention to practice. Furthermore, one of ordinary skill in the art would not necessarily have knowledge of the Allard et al. patent application (which did not issue until June 19, 2001). 35 USC § 103(a) does not contemplate that one of skill in the art could not have known of the Allard et al. application. Therefore, the subject matter contained in Allard et al., whether viewed in isolation, or in combination with any other reference, could not have been obvious as of the date of invention, February 16, 2001. Allard et al. cannot be used as a teaching reference for the rejection of any of the claims under 35 U.S.C. 103(a).

Moreover, the Examiner states that the arguments presented regarding 35 USC § 103(a) are unpersuasive because "Applicant does not argue what he claims but arguing [*sic*] what contain in the specification." This, if true, has been corrected by amendment. The Examiner asserts that the fact that Applicant's system can be remotely used is unpersuasive since remote use of Katz et al. includes Applicant's intended use. However, the Applicant does not refer to any remote use anywhere in its claims, and only refers to remote use in the specification to demonstrate that remote use comprises but one optional application of the invention. However, Applicant's limitation and particular

implementation of local use (termed ISS in the Specification, Page 15-16, ¶3) does not appear in Katz et al.

In regards to the Examiner's arguments on page 3, Claim Rejections – 35 USC § 103, Allard et al. does teach the assignment of a consumer profile, but only in an internet context. Also, Allard et al., assigns a consumer profile with limited and quite dissimilar characteristics and objectives from that of Applicant. For example, in Allard et al., the consumer profile contemplates mainly accounting data such as "historical purchase data, personal information, charge authorization data and the like." In contrast, the Applicant's consumer profile is used in an intranet and employs data useful in soliciting sales by region, age, sex, discounts, and other lifestyle criteria, which are not relevant to Allard et al. For example in Fig. 8, there is provided an overview of the manner of use of the TOTALSHOP system by corporate management and communication of information from upper management, to operating divisions, to retail store locations and, ultimately, to the TOTALSHOP customer. This information appears for most part, as changes or modifications within the product information E3 and options database E4-E6 (See Fig. 7), that is, a part of the TOTALSHOP intranet. The TOTALSHOP intranet also provides a means by which management can rapidly respond to regional, seasonal, price, style, and other vital issues within the retail environment, this all in the context of a visually dynamic store. (Specification, Pages 18-19, ¶3).


More importantly, the instant application states "The step of accessing suggestion categories includes the step of sorting each category in accordance with one or more criteria including **geographical region, season, age of shopper, other personal data profile of the shopper, price range of interest, current discounts, random, and priorities of management.**" (Specification, Pages 6-7) (emphasis added) Such a profile is generic in that it can be used to typify the likes and dislikes of the particular consumer by age, region, sex or any other criteria which can be linked to shopping preferences.

It should also be noted that the TOTALSHOP program can also enable a smaller location of a much larger retail chain to display inter-relate the entire product scope of the chain. The customer may also enjoy a touch and feel experience in choosing items, although the particular smaller retailer need not physically have the particular items in store, for these items may be shipped using the ISS kiosks. The system includes program means, in digital communication with a sales station, for processing payment and effecting direct customer delivery from a remote location of merchandise not in stock at the local establishment to any address designated by a customer at a time of purchase or to an address already resident within the customer profile database. (Specification, Page 7-8, ¶2). In Fig. 13 there is provided a further illustration of the greater space and openness which is enabled upon the shopping floor of the retail establishment. (Specification, Page 22, ¶2). This, in many cases, will facilitate display of only a single sample of one piece of merchandise, as opposed to many racks and shelves of like product.

It is respectfully requested the above arguments overcome the prior art of record, and the claims have been amended to more specifically define the invention and, to place the application in condition for allowance. Applicant's Agent respectfully requests direct telephone communication from the Examiner with a view toward any further action deemed necessary to place the application in final condition for allowance.

6.22.05
Date of Signature

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